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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,975	10/05/2005	Robert S. Meissner	20880P	3364

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MERCK AND CO., INC  
P O BOX 2000  
RAHWAY, NJ 07065-0907

EXAMINER
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RAMACHANDRAN, UMAMAHESWARI

ART UNIT	PAPER NUMBER
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1617

MAIL DATE	DELIVERY MODE
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08/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/551,975	<b>Applicant(s)</b> MEISSNER ET AL.	
	<b>Examiner</b> Umamaheswari Ramachandran	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14, 15, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14, 15, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

The examiner notes the receipt of the amendments and remarks received in the office on 5/24/2007 canceling claims 1-13, 16-21 and adding new claims 22-25. Claims 24-25 are withdrawn from consideration as the species elected by the examiner (species elected by the Applicants' is free of prior art) is found in prior art. Since applicant has received an action on the merits for the originally presented invention Group II, claims 14-15, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 24-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP 821.03. Claims 14, 15, 22, 23 are pending.

***Response to Remarks***

Applicants' arguments regarding rejection of claims 14 and 15 under U.S.C 102 as being anticipated by Witzel (US 5,639,741) has been fully considered but they are not persuasive. Accordingly, the rejections of the claims 14 and 15 are being maintained. The limitations of additional new claims 22 and 23 fall within the scope of the rejected claims and hence have been rejected under the same 35 U.S.C 102 rejections that was made in the previous office action (non-final rejection). In view of addition of new claims modified 35 U.S.C 102 rejections are now made. The Office Action is made Final.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14 , 15, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Witzel et al (U.S. 5,639,741).

Witzel et al. teaches a compound (compound 12 of claim 15 of the instant application) 4-methyl-17 $\beta$  -(2-fluorobenzamido)-5 $\alpha$ -4-aza-androstan-1-ene-3-one (col. 60, lines 5-6) and this addresses claims 14 and 15. The reference further teaches the following compounds: 17-(2,6-Difluorobenzamido)-4-methyl-5 $\alpha$ -4-azaandrostan-1-en-3-one (col. 60, lines 42-43), 17-(2,3-Difluorobenzamido)-4,7-dimethyl-5 $\alpha$ -4-azaandrostan-1-en-3-one (col. 60, lines 44-45), 4-Methyl-17-(3-fluoro-2-methylbenzamido)-5 $\alpha$ -4-azaandrostan-1-en-3-one (col. 60, lines 29-30) and 4-methyl-17 $\beta$  -(propamido)-4-aza-5 $\alpha$ -androst-1-ene-3-one.

### ***Response to Arguments***

Applicants' argue that the species, 4-methyl- 17 $\beta$ -(2-fluorobenzamido)-4-aza-5  $\alpha$ -androst- 1-ene-3-one (RN 154112-38-6, compound 12 of claim 15, species elected by the examiner as the elected species is free of prior art) and other species rejected under U.S.C. 102(b) is not found in Witzel et al. In response, the examiner has inadvertently pointed the reference to col. 18 and 19 instead of col. 60. The species rejected under U.S.C. 102(b) are taught by Witzel et al. (see col. 60, lines 5-6, 29-30, 42-45). The Applicants' argue that species "4-methyl-17 $\beta$  -(propamido)-4-aza-5 $\alpha$ -androst-1-ene-3-one" is not taught by Witzel. A structure search of the compound reveals that Witzel et

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al. teaches the compound and the registry number of the rejected species is 154112-55-

7.

### **Conclusion**

No Claims are allowed.

Applicant's amendment and the addition of new claims necessitated the modified rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Umamaheswari Ramachandran whose telephone number is 571-272-9926. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER